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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|---------------------|------------------|
| 08/941,459 | 09/30/1997 | TAKESHI MORIKAWA | 05058/58201 | 6001 |
| 24367 | 7590 | 01/26/2005 | EXAMINER | |
| SIDLEY AUSTIN BROWN & WOOD LLP | | | POKRZYWA, JOSEPH R | |
| 717 NORTH HARWOOD | | | ART UNIT | PAPER NUMBER |
| SUITE 3400 | | | | |
| DALLAS, TX 75201 | | | 2622 | |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 08/941,459 | MORIKAWA, TAKESHI |
| | Examiner | Art Unit |
| | Joseph R. Pokrzwa | 2622 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 November 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4-6,13-16 and 23-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4-6,13-16 and 23-30 is/are allowed.
- 6) Claim(s) 31-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/4/04 has been entered.

Response to Amendment

2. Applicant's amendment received on 8/9/04 has been entered and made of record. Currently, claims 4-6, 13-16, and 23-35 are pending.

Response to Arguments

3. Applicant's arguments, see pages 13-15, filed 8/9/04, with respect to the rejection(s) of claim(s) 31-35 under 35 U.S.C. 102(b) as being anticipated by Sumida et al. (U.S. Patent Number 5,383,754), and under 35 U.S.C. 103(c) as being unpatentable over Sumida et al. in view of Yoshida et al. (U.S. Patent Number 5,930,006), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sumida et al. and Yoshiura et al. (U.S. Patent Number 4,739,369, cited in the Information Disclosure Statement dated 5/16/03).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 31-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumida *et al.* (U.S. Patent Number 5,383,754, cited in the Office action dated 4/6/04) in view of Yoshiura *et al.* (U.S. Patent Number 4,739,369, cited in the Information Disclosure Statement dated 5/16/03).

Regarding **claim 31**, Sumida discloses an image formation apparatus (see abstract, and Fig. 1) comprising a sensor for reading an image on an original (column 17, line 25 through column 18, line 57), a memory for storing pixel density data read by the sensor (column 19, lines 4 through 37), means for editing pixel density data from the pixel density data stored in the memory (column 19, lines 38 through 49), an image forming portion for using edited pixel density data to print an image (column 13, line 65 through column 14, line 43, and column 19, lines 4 through 30), a feeder capable of feeding originals having different sizes to an image reading position (column 15, lines 9 through 24), means for reading mixed originals for reading a plurality of originals collectively set in the feeder (column 17, lines 2 through 60), means for determining a size of an image corresponding to the pixel density data of each image stored in the memory (column 43, line 51 through column 46, line 36), and means for controlling, responsive to the means for determining, which permits the means for editing to edit an image when all images corresponding to the plurality of originals are uniform in size (column 39, line

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43 through column 40, line 62, column 47, line 53 through column 50, line 15, and column 74, lines 14 through 64) and otherwise prohibiting the means for editing from editing an image (column 30, line 33 through column 31, line 26, and column 74, lines 14 through 64).

However, Sumida fails to expressly disclose if the feeder is capable of *successively* feeding originals having different sizes to an image reading position, and reading a plurality of originals of *different sizes* collectively set in the feeder.

Yoshiura discloses an image forming apparatus (see Fig. 2) comprising a sensor for reading an image on an original (column 7, lines 10-56), a memory for storing data read by the sensor (column 9, lines 26-65), means for editing data from the data stored in the memory (column 9, lines 26-65, and column 11, lines 24-61), an image forming portion for using edited data to print an image (column 7, lines 10-56), a feeder capable of successively feeding originals having different sizes to an image reading position (column 8, lines 3-42), means for reading mixed originals for reading a plurality of originals of different sizes collectively set in the feeder (column 9, line 60-column 10, line 38), means for determining a size of an image corresponding to the pixel density data of each image stored in the memory (column 10, line 2-column 11, line 23), and means for controlling, responsive to the means for determining, which permits the means for editing to edit an image when all images corresponding to the plurality of originals are uniform in size (column 11, lines 39-61).

Sumida & Yoshiura are combinable because they are from the same field of endeavor, being copying systems, with both having an automatic document feeder to feed originals to be read. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a feeder taught by Yoshiura that successively feeds different size originals and

subsequently, reading the originals of different sizes collectively set in the feeder, within the system of Sumida. The suggestion/motivation for doing so would have been that Sumida's system would become more efficient with the inclusion of Yoshiura's teachings, since an operator would be allowed to realize an abnormal copying function based on automatically detected differing original sizes, as recognized by Yoshiura in column 2, lines 39-51. Therefore, it would have been obvious to combine the teachings of Yoshiura with the system of Sumida to obtain the invention as specified in claim 31.

Regarding *claim 32*, Sumida and Yoshiura disclose the apparatus discussed above in claim 31, and Yoshiura further teaches that the means for editing data edits an image in the manner suitable for providing two images for printing on a single side of a sheet (column 2, lines 17-60).

Sumida & Yoshiura are combinable because they are from the same field of endeavor, being copying systems, with both having an automatic document feeder to feed originals to be read. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Yoshiura that successively feeds and reads different size originals and subsequently, providing two images for printing on a single side of a sheet, within the system of Sumida. The suggestion/motivation for doing so would have been that Sumida's system would become more efficient with the inclusion of Yoshiura's teachings, since an operator would be allowed to realize an abnormal duplex copying function based on automatically detected differing original sizes, as recognized by Yoshiura in column 2, lines 39-51. Therefore, it would have been obvious to combine the teachings of Yoshiura with the system of Sumida to obtain the invention as specified in claim 32.

Regarding *claim 33*, Sumida discloses an image formation apparatus (see abstract, and Fig. 1) comprising a sensor for reading an image on an original (column 17, line 25 through column 18, line 57), a memory for storing data read by the sensor (column 19, lines 4 through 37), an image forming portion for using edited data stored in the memory to print an image (column 13, line 65 through column 14, line 43, and column 19, lines 4 through 30), a stapler for stapling a plurality of sheets each bearing a formed image thereon (column 15, lines 26 through 52), a feeder capable of feeding originals having different sizes to an image reading position (column 15, lines 9 through 24), means for reading mixed originals for reading a plurality of originals collectively set in the feeder (column 17, lines 2 through 60), means for determining a size of an image corresponding to data of each image stored in the memory (column 43, line 51 through column 46, line 36), and means for controlling, responsive to the means for determining, which permits the stapler to operate when all images corresponding to the plurality of originals are uniform in size (column 39, line 43 through column 40, line 62, column 47, line 53 through column 50, line 15, and column 74, lines 14 through 64) and otherwise prohibiting the stapler from operating (column 30, line 33 through column 31, line 26, and column 74, lines 14 through 64).

However, Sumida fails to expressly disclose if the feeder is capable of *successively* feeding originals having different sizes to an image reading position, and reading a plurality of originals *of different sizes* collectively set in the feeder.

Yoshiura discloses an image forming apparatus (see Fig. 2) comprising a sensor for reading an image on an original (column 7, lines 10-56), a memory for storing data read by the sensor (column 9, lines 26-65), means for editing data from the data stored in the memory

(column 9, lines 26-65, and column 11, lines 24-61), an image forming portion for using edited data to print an image (column 7, lines 10-56), a feeder capable of successively feeding originals having different sizes to an image reading position (column 8, lines 3-42), means for reading mixed originals for reading a plurality of originals of different sizes collectively set in the feeder (column 9, line 60-column 10, line 38), means for determining a size of an image corresponding to the pixel density data of each image stored in the memory (column 10, line 2-column 11, line 23), and means for controlling, responsive to the means for determining, which permits the means for editing to edit an image when all images corresponding to the plurality of originals are uniform in size (column 11, lines 39-61).

Sumida & Yoshiura are combinable because they are from the same field of endeavor, being copying systems, with both having an automatic document feeder to feed originals to be read. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a feeder taught by Yoshiura that successively feeds different size originals and subsequently, reading the originals of different sizes collectively set in the feeder, within the system of Sumida. The suggestion/motivation for doing so would have been that Sumida's system would become more efficient with the inclusion of Yoshiura's teachings, since an operator would be allowed to realize an abnormal copying function based on automatically detected differing original sizes, as recognized by Yoshiura in column 2, lines 39-51. Therefore, it would have been obvious to combine the teachings of Yoshiura with the system of Sumida to obtain the invention as specified in claim 33.

Regarding *claim 34*, Sumida discloses an image formation apparatus (see abstract, and Fig. 1) comprising a feeder capable of feeding originals having different sizes to an image

reading position (column 15, lines 9 through 24), a reader for reading a plurality of originals collectively set in the feeder (column 17, lines 2 through 60), a memory for storing pixel density data corresponding to a plurality of images (column 19, lines 4 through 37), means for editing the pixel density data stored in the memory (column 24, line 50 through column 27, line 8), and means for controlling, which permits the means for editing to operate when all the pixel density data stored in the memory are uniform in image size (column 39, line 43 through column 40, line 62, column 47, line 53 through column 50, line 15, and column 74, lines 14 through 64) and otherwise prohibiting the means for editing from operating (column 30, line 33 through column 31, line 26, and column 74, lines 14 through 64).

However, Sumida fails to expressly disclose if the feeder is capable of *successively* feeding originals having different sizes to an image reading position, and reading a plurality of originals *of different sizes* collectively set in the feeder. Further, Sumida fails to expressly teach if the means for editing edits in a manner suitable for providing two images on a single side of a sheet.

Yoshiura discloses an image forming apparatus (see Fig. 2) comprising a feeder capable of successively feeding originals having different sizes to an image reading position (column 8, lines 3-42), a reader for reading a plurality of originals of different sizes collectively set in the feeder (column 9, line 60-column 10, line 38), a memory for storing data corresponding to a plurality of images (column 9, lines 26-65), means for editing the data stored in the memory in a manner suitable for providing two images on a single side of a sheet (column 2, lines 17-60, column 9, lines 26-65, and column 11, lines 24-61), and means for controlling, which permits the

means for editing to operate when all data stored in the memory are uniform in size (column 11, lines 39-61).

Sumida & Yoshiura are combinable because they are from the same field of endeavor, being copying systems, with both having an automatic document feeder to feed originals to be read. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Yoshiura that successively feeds and reads different size originals and subsequently, providing two images for printing on a single side of a sheet, within the system of Sumida. The suggestion/motivation for doing so would have been that Sumida's system would become more efficient with the inclusion of Yoshiura's teachings, since an operator would be allowed to realize an abnormal duplex copying function based on automatically detected differing original sizes, as recognized by Yoshiura in column 2, lines 39-51. Therefore, it would have been obvious to combine the teachings of Yoshiura with the system of Sumida to obtain the invention as specified in claim 34.

Regarding *claim 35*, Sumida discloses an image formation apparatus (see abstract, and Fig. 1) comprising a feeder capable of feeding originals having different sizes to an image reading position (column 15, lines 9 through 24), a reader for reading a plurality of originals collectively set in the feeder (column 17, lines 2 through 60), a memory for storing pixel density data corresponding to a plurality of images (column 19, lines 4 through 37), a print portion for forming an image on a sheet from the pixel density data stored in the memory (column 13, line 65 through column 14, line 43, and column 19, lines 4 through 30), a stapler for stapling a plurality of printed sheets (column 15, lines 26 through 52), and a controller for which permits the stapler to operate when all of the plurality of printed sheets have images formed thereon from

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the pixel density data stored in the memory which are uniform in size (column 39, line 43 through column 40, line 62, column 47, line 53 through column 50, line 15, and column 74, lines 14 through 64) and otherwise prohibiting the stapler from operating (column 30, line 33 through column 31, line 26, and column 74, lines 14 through 64).

However, Sumida fails to expressly disclose if the feeder is capable of *successively* feeding originals having different sizes to an image reading position, and reading a plurality of originals of *different sizes* collectively set in the feeder.

Yoshiura discloses an image forming apparatus (see Fig. 2) comprising a feeder capable of successively feeding originals having different sizes to an image reading position (column 8, lines 3-42), means for reading mixed originals for reading a plurality of originals of different sizes collectively set in the feeder (column 9, line 60-column 10, line 38), a memory for storing data corresponding to a plurality of images (column 9, lines 26-65), a print portion for forming an image on a sheet from the data stored in the memory (column 7, lines 10-56), means for editing the data stored in the memory (column 9, lines 26-65, and column 11, lines 24-61), and a controller which permits the means for editing to operate when all the plurality of printed sheets have images formed thereon from the data stored in the memory which are uniform in size (column 11, lines 39-61).

Sumida & Yoshiura are combinable because they are from the same field of endeavor, being copying systems, with both having an automatic document feeder to feed originals to be read. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a feeder taught by Yoshiura that successively feeds different size originals and subsequently, reading the originals of different sizes collectively set in the feeder, within the

system of Sumida. The suggestion/motivation for doing so would have been that Sumida's system would become more efficient with the inclusion of Yoshiura's teachings, since an operator would be allowed to realize an abnormal copying function based on automatically detected differing original sizes, as recognized by Yoshiura in column 2, lines 39-51. Therefore, it would have been obvious to combine the teachings of Yoshiura with the system of Sumida to obtain the invention as specified in claim 35.

Allowable Subject Matter

6. **Claims 4-6, 13-16, and 23-30** are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding ***claims 4, 13, and 28***, in the examiner's opinion, it would not have been obvious to have the systems, as claimed, include an operational panel for selecting operable modes of operation, whereby the display and selection of an inoperable mode of operation through the operation panel is automatically prohibited based on the result of the comparison between the state of at least two frames. The closest prior art, Sumida *et al.* (U.S. Patent Number 5,383,754), fails to teach these limitations, and the examiner finds no motivation to combine Sumida with other references to achieve the desired outcome. Because of this, the claims are rendered allowable.

Regarding ***claim 23***, in the examiner's opinion, it would not have been obvious to have the system, as claimed, include a memory for storing a plurality of print jobs, with each print job containing pixel density data of at least two frames, a print-job selector for selecting one of the

plurality of print jobs stored in the memory, and a state decision controller for determining, for each frame, a state of a frame of the pixel density data contained in the selected print-job. The closest prior art, Sumida *et al.* (U.S. Patent Number 5,383,754), fails to teach these limitations, and the examiner finds no motivation to combine Sumida with other references to achieve the desired outcome. Because of this, the claim is rendered allowable.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp

